

REMARKS/ARGUMENTS

This Amendment is being filed concurrently with a Request for Continued Examination (RCE). With this Amendment, Applicant amends claims 1, 3 and 9. No new matter is added. For instance, support for the amendments to claims 1 and 9 may be found at least in paragraphs [0020] – [0023] of the originally-filed specification. Claims 1, 3-6 and 9-17 are all the claims currently pending in the application. However, claims 10-17 are withdrawn from consideration. Based on the foregoing amendments and the following remarks, Applicant respectfully requests reconsideration of the application and allowance of the claims.

I. Rejection of Claims 1 & 3-6 Under 35 U.S.C. § 112, second paragraph

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In rejecting claim 1, the Examiner asserts that the “phrase ‘otherwise said set of workstations includes a pharmacist review workstation’” renders the claim unclear. (See pg. 2 of the Office Action)

Applicant herein amends independent claim 1 and submits that these self-explanatory claim amendments overcome the rejection. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the § 112, second paragraph rejection of claim 1 and its dependent claims 3-6.

II. Rejection of Claim 9 Under 35 U.S.C. § 102(e)

Claim 9 stands rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Hebron et al. (U.S. Patent Appln. Publn. No. 2003/0066841; hereinafter “Hebron”).

Claim 9 recites, *inter alia*, a method comprising evaluating a queue of orders to determine whether one or more prescriptions within each order is fillable in an automated manner or a non-automated manner and determining a set of equipment for each prescription *based on said evaluating*. In response to the determination revealing that at least one of the prescriptions is fillable in an automated manner, the method further comprises *selecting a first subset of said equipment*. The first subset comprises automated equipment that *excludes a*

pharmacist review workstation for reviewing a respective filled order. In response to the determination revealing that at least one of the prescriptions is fillable in a non-automated manner, the method further comprises *selecting a second subset* of said equipment. The second subset comprises non-automated equipment *that includes the pharmacist review workstation*.

Hebron does not teach or suggest at least in response to determining that at least one of the prescriptions is fillable in an automated manner, *based on an evaluation of orders*, selecting a first subset of said equipment that excludes a pharmacist review workstation for reviewing a respective filled order *and* in response to determining that at least one of the prescriptions is fillable in a non-automated manner, *based on an evaluation of orders*, selecting a second subset of said equipment that includes the pharmacist review workstation, as recited by claim 1.

In contrast to claim 9, Hebron at most discloses a system having a line of machines that is provided for automatically dispensing prescriptions according to a patient's order. (paragraphs [0092] – [0095] & Abstract of Hebron) Hebron at most explains that if a prescription has not been successfully filled by the automated equipment, “then a signal is issued to alert the system operator or pharmacist of the partially filled vial and the vial is handled appropriately.” (paragraph [0110] of Hebron)

In view of the foregoing, Hebron at most discloses utilization of machines to automatically fill orders and in the event that prescriptions are not successfully filled automatically, notifying a pharmacist to resolve the problem. However, Hebron is altogether silent and does not contemplate *selection of a second subset of equipment* that includes a pharmacist review workstation in response to determining that at least one prescription in an order is fillable in a non-automated manner *on the basis of an evaluation of orders* having one or more prescriptions, as recited by claim 9. In contrast to claim 9, upon evaluating a patient's order, Hebron at most discloses utilizing machines to automatically fill the patient's prescription order and does not teach or suggest selection of a second subset of equipment that includes a pharmacist review workstation for reviewing a respective filled order in response to determining that a prescription within an order is fillable in automated manner *on the basis of evaluating the orders* and selecting a different subset of equipment for filling a prescription in an automated manner *on the basis of evaluating the orders*, as recited by claim 9.

Based on at least the foregoing reasons, Applicant submits that Hebron does not teach or suggest all of the features of claim 9. Applicant therefore respectfully requests reconsideration and withdrawal of the § 102(e) rejection of independent claim 9.

III. Rejection of Claims 1 & 3-6 Under 35 U.S.C. § 103(a)

Claims 1 and 3-6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hebron in view of Spaulding et al. (U.S. Patent No. 5,337,919; hereinafter "Spaulding")

Claim 1 recites, *inter alia*, a method of discriminating between orders, comprising *evaluating a queue of orders* to determine whether one or more prescriptions within each order is fillable in an automated manner or a non-automated manner and *determining a set of workstations* for each prescription *based on said evaluating*. In response to the determination revealing that at least one of the prescriptions is fillable in an automated manner, the method further comprises *selecting a first subset* of said workstations that *excludes a pharmacist review workstation* for reviewing a respective filled order. In response to the determination revealing that at least one of the prescriptions is fillable in a non-automated manner, the method further comprises *selecting a second subset* of said workstations that *includes the pharmacist review workstation*.

The combination of Hebron and Spaulding does not teach or suggest at least in response to determining that at least one of the prescriptions is fillable in an automated manner, *based on an evaluation of orders*, selecting a first subset of said workstations that excludes a pharmacist review workstation for reviewing a respective filled order *and* in response to determining that at least one of the prescriptions is fillable in a non-automated manner, *based on an evaluation of orders*, selecting a second subset of said workstations that includes the pharmacist review workstation, as recited by claim 1.

As discussed above with respect to claim 9, Hebron does not disclose the above feature of claim 1 and Applicant submits that Spaulding does not make up for what Hebron lacks. Spaulding like Hebron relates to an automated prescription dispensing system having pill dispenser units mounted therein for filling vials. (Col. 8, lines 20-27 & Abstract of Spaulding) In this regard, Spaulding explains that the automatic prescription dispensing system greatly

enhances productivity and decreases the tedious aspects of filling prescriptions. (Col. 5, lines 19-22 & Col. 6, lines 12-16 of Spaulding)

Spaulding, alone or in combination with Hebron, at most discloses that during the process of automatically dispensing pills 12, when there is a discrepancy between a sensed weight of the pills and an expected weight of the pills an alert is provided to a display panel 31 of a pharmacist to check the count of the pills. (Col. 11, lines 59-68 of Spaulding)

In view of the foregoing, Spaulding and Hebron, alone or in combination, at most discloses utilization of dispensing pill units to automatically fill orders and in the event that a sensed weight of the pills does not match an expected weight of the pills, sounding an alarm to notify a pharmacist of the problem. However, Spaulding and Hebron, alone or in combination is altogether silent and does not contemplate selection of a second subset of workstations that includes a pharmacist review workstation in response to determining that at least one prescription in an order is fillable in a non-automated manner on the basis of an evaluation of orders having one or more prescriptions, as recited by claim 9.

In contrast to claim 9, upon evaluating a patient's order, Spaulding, alone or in combination with Hebron, at most discloses utilizing machines to automatically fill the patient's prescription order and does not teach or suggest selection of a second subset of equipment that includes a pharmacist review workstation for reviewing a respective filled order in response to determining that a prescription within an order is fillable in an automated manner and selecting a different subset of equipment for filling a prescription in an automated manner, as recited by claim 9. Spaulding, alone or in combination with Hebron, at most discloses usage of a pharmacist review in an automated process when there is some type of problem with the automated process which is in contrast to claim 1 which recites selection of a second subset of workstations that includes a pharmacist review workstation for reviewing a respective filled order *on the basis of evaluating orders* in response to determining that a prescription within the order is fillable in a non-automated manner and selecting a different subset of workstations that excludes a pharmacist review workstation in response to determining that a prescription is fillable in an automated manner on the *basis of evaluating the orders*.

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As such, claim 1 allows “discrimination between various types of orders to ... fill the order in the most efficient manner” and “increase throughput”. (paragraph [0004] of the originally-filed specification) The dispensing systems of Spaulding and Hebron, alone or in combination does not teach or suggest this feature of claim 1

For at least the foregoing reasons, Applicant submits the combination of Hebron and Spaulding is deficient and does not teach or suggest all of the features of claim 1. Applicant therefore respectfully requests reconsideration and withdrawal of the § 103(a) rejection of claim 1 and its dependent claims 3-6.

IV. Conclusion

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. Examiner Porter is encouraged to contact Applicant’s undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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